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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,014	06/23/2003	Steve C. MacWilliams	00725.0356-US-C3	7672
7590	12/02/2004		EXAMINER HENDERSON, MARK T	
Michael B. Lasky Altera Law Group Suite 100 6500 City West Parkway Minneapolis, MN 55344-7704			ART UNIT	PAPER NUMBER
			3722	
			DATE MAILED: 12/02/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

as

Office Action Summary	Application No. 10/602,014	Applicant(s) MACWILLIAMS ET AL.	
	Examiner Mark T Henderson	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36 and 41-44 is/are rejected.
- 7) ☒ Claim(s) 37-40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/26/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1-35 have been canceled. Claims 36-44 have been added.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 36, 41-44 are finally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,352,286. Although the conflicting claims are not identical, they are not patentably distinct from each other because both disclose a folder blank apparatus comprising: a plurality of interconnected folders, wherein one panel is detachable connected to another panel; wherein each folder comprises two foldable panels; a folder panel having an elongated tab along one side of the folder comprising a length, a width, wherein the tabs are also foldable along a line extending the width of the tab.

However, MacWilliams does not disclose: wherein the folder blanks are alternatingly sequentially connected; wherein the second panel includes an elongated portion extending partially

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along the side of the folder; wherein the elongated portion comprises a length, width, foldable along a second fold line extending the length of the elongated portion; and wherein the indicia is a repeating pattern of a plurality of color bars of four colors; wherein the pattern repeats four times; and wherein a first color forms one bar; and wherein the plurality of colors are monochromatic.

Hure discloses in Fig. 1 and 2, a folder apparatus comprising an elongated (28) being foldable about a second fold line (32c) and extending parallel to one side of the folder blank (see Fig. 1); wherein the elongated portion comprises a length, a width, an edge surface that extends the length of the elongated portion to reinforce a portion of the second panel.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify MacWilliams et al's apparatus with a folder apparatus having an elongated portion as taught by Hure for the purpose of providing a stronger means in which secure the tabbed portion between two folder panels.

In regards to **Claim 36**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the interconnected folder blanks in any desirable order along the connecting web, since it has been held that rearranging parts of an invention involves only routine skill in the art. Therefore, it would have been obvious to place the interconnected folder blanks in any desirable order along the connecting web, since it applicant has not stated the criticality of having the folder blanks in a particular order, and invention would function equally as well if the blanks were placed in any order either sequentially or non-sequentially.

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In regards to **Claims 41-44**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include any type of indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter (pattern of colored bars) placed on the substrate (tab) may render the device more convenient by providing an individual with a specific type of information index display does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Therefore, it would have been obvious to place any type of indicia on the tab portion, since applicant has not disclosed the criticality of having the particular indicia, and invention would function equally as well with any type of indexing indicia display.

3. Claims 36, 41-44 are finally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18 of U.S. Patent No. 5,906,397. Although the conflicting claims are not identical, they are not patentably distinct from each other because both disclose a folder blank comprising: a plurality of interconnected folders, wherein one panel is detachable connected to another panel; wherein each folder comprises two foldable panels; a folder panel having an elongated tab along one side of the folder comprising a length, a width, wherein the tabs are also foldable along a line extending the width of the tab.

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However, MacWilliams does not disclose: wherein the folder blanks are alternatingly sequentially connected; wherein the second panel includes an elongated portion extending partially along the side of the folder; wherein the elongated portion comprises a length, width, foldable along a second fold line extending the length of the elongated portion; and wherein the indicia is a repeating pattern of a plurality of color bars of four colors; wherein the pattern repeats four times; and wherein a first color forms one bar; and wherein the plurality of colors are monochromatic.

Hure discloses in Fig. 1 and 2, a folder apparatus comprising an elongated (28) being foldable about a second fold line (32c) and extending parallel to one side of the folder blank (see Fig. 1); wherein the elongated portion comprises a length, a width, an edge surface that extends the length of the elongated portion to reinforce a portion of the second panel.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify MacWilliams et al's apparatus with a folder apparatus having an elongated portion as taught by Hure for the purpose of providing a stronger means in which secure the tabbed portion between two folder panels.

In regards to **Claim 36**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the interconnected folder blanks in any desirable order along the connecting web, since it has been held that rearranging parts of an invention involves only routine skill in the art. Therefore, it would have been obvious to place the interconnected folder blanks in any desirable order along the connecting web, since it applicant has not stated the

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criticality of having the folder blanks in a particular order, and invention would function equally as well if the blanks were placed in any order either sequentially or non-sequentially.

In regards to **Claims 41-44**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include any type of indica, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter (pattern of colored bars) placed on the substrate (tab) may render the device more convenient by providing an individual with a specific type of information index display does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Therefore, it would have been obvious to place any type of indicia on the tab portion, since applicant has not disclosed the criticality of having the particular indica, and invention would function equally as well with any type of indexing indicia display.

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Allowable Subject Matter

4. Claims 37-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments with respect to claims 36-44 have been considered but are moot in view of the new ground(s) of rejection.

MacWilliams (6,352,286 and 5,906,397) are now used to disclose a folder apparatus having a plurality of detachably interconnected folder blanks.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.

MTH

November 28, 2004



Daniel W. Howell
Primary Examiner
Art Unit 3722